REMARKS/ARGUMENTS

This Amendment is submitted in response to the Non-Final Action of December 3, 2004, in which independent claims 12 and 20 have been rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent 5,984,679 to Farzin-Nia et al. and in which claims 12, 16-20 and 24-27 have been rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 4,776,330 to Chapman et al. in view of U.S. Patent 6,132,389 to Cornish et al. These rejections are respectfully traverse in light of the claim amendments made herein.

Claims 12 and 20, as now amended, are limited to an intravascular guidewire adapted for insertion into the vascular system of a patient during the course of a catheterization procedure. Further amendments have been made to claims 12 and 20 to recite that the diameter of the wire used in fabricating the guidewire has a diameter in a specified range of from 0.005 inch and 0.040 inch over a predetermined length dimension thereof. Finally, claims 12 and 20 require that the distal end portion be tapered to a lesser diameter than the diameter of the proximal end portion and that the distal end portion terminate in a rounded distal tip.

The Farzin-Nia '679 patent is directed to a method for fabricating dental files and, in that regard, has little to do with intravascular guidewires. Claims 12 and 20 cannot be said to be anticipated by the Farzin-Nia reference in that the dental files described in the specification and depicted in the drawings of the '679 patent do not disclose a wire of round cross-section exhibiting a diameter. Instead, in cross-section the Farzin-Nia et al. files exhibit square, triangular, rhomboid and other irregular patterns. Moreover, as now amended, claims 12 and 20 call for a rounded distal tip on the guidewire. The distal tip of the files depicted in the '679 patent are sharply pointed.

For the reasons advanced, then, applicant's independent claims 12 and 20 are not anticipated by the cited '679 patent and that rejection should be withdrawn.

In rejecting claims 12, 16-29 and 24-27, under 35 U.S.C. §103(a), the Examiner has apparently misread the cited Chapman '330 patent. It does not disclose a guidewire having approximately 78% titanium, 11.5% molybdenum, 6% zirconium and 4.5% tin by

weight as the Examiner has contended. **A careful reading of the reference reveals that it is silent as to the alloy used in fabricating the guidewire 25 shown in Figures 3, 4 and 5 Of the '330 patent.**

Admittedly, the '330 patent states at column 4, lines 16-19, that the components of the kit of the invention are made from the claimed alloy, there is no indication that the guidewire is a component of the kit. In this regard, reference is made to the Abstract, to the "Summary of the Invention" which lists all of the kit components. Further, at column 3, lines 21-23, lines 34-37, lines 44-46, and column 4, lines 34-65, there is recited components of the kit that may be made from the titanium alloy claimed by applicant, but there is nothing in those materials that suggest that the guidewire 25 in the '330 patent is made of that alloy or that it is packaged as a part of the kit.

There are several other passages in the reference referring to the guidewire 25, but none suggests that the alloy claimed by applicant should or could be used in fabricating the guidewire 25.

The components of the kit described in the Chapman '330 patent comprise rods, plates, screws, etc., albeit made from titanium molybdenum zirconium tin alloy, but that is not a sufficient teaching that this alloy would be suitable for fabricating intravascular guidewires. Thus, even if Chapman and the Cornish patents are considered together, there is no teaching or suggestion in either that applicant's claimed alloy be employed in the fabrication of intravascular guidewires. Certainly, the Examiner is not contending that because dental files and bone screws are made of a titanium, molybdenum, zirconium, tin alloy, it would be "obvious to try" that alloy in fabricating intravascular guidewires. The CAFC has frequently rejected the "obvious to try" basis for 35 U.S.C. §103(a) claim rejection.

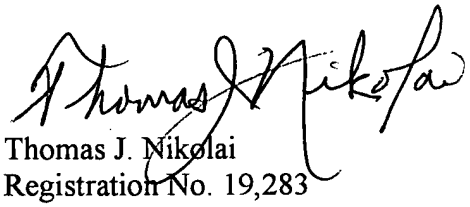
Applicant was first to invent an intravascular guidewire for use in catheterization procedures made from a titanium, molybdenum, zirconium and tin alloy, at least as evidenced by the prior art cited to date in the prosecution of the present application. During the course of the personal interview held with the Examiner on October 27, 2004, a demonstration was given comparing the performance of applicant's guidewire with a stainless steel guidewire and with a nickel titanium guidewire in traversing a tortuous

path where pushability, torqueability and trackability were observed. That demonstration showed that applicant's titanium molybdenum alloy guidewire clearly out-performed the guidewires most commonly used today.

In that the claims, as now amended, define over the prior art, claims 12-16-20 and 24-27 remaining in the application are in condition for allowance and a Notice to that effect is respectfully solicited.

Respectfully submitted,

NIKOLAI & MERSEREAU, P.A.



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CERTIFICATE OF MAILING

I hereby certify that the foregoing Amendment in response to the Office Action of December 3, 2004, in application Serial No. 09/760,136, filed on January 12, 2001, of Stephen Nuss entitled "Titanium Molybdenum Alloy Guidewire" is being deposited with the U.S. Postal Service as First Class mail in an envelope addressed to: Mail Stop Non-Fee Amendments, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, postage prepaid, on December 13, 2004.

Date of Signature: December 13, 2004.

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